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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
LILLIS, E

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 05/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/996,249

Applicant(s)
Sams et al

Examiner
Eileen D. Lillis

Group Art Unit
3629



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) 6-9 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5 and 10-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5 and 10-11, drawn to drawn to a tripod bearing assembly, classified in class 464, subclass 122.
- II. Claims 6-9, drawn to drawn to a method of assembling a tripod bearing assembly, classified in class 29, subclass 898.06.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as assembling the needles on the trunnion and then placing the outer race on the bearings.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with James Dottavio on 21 May 1999 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-5 and 10-12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-9 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The disclosure is objected to because of the following: it is unclear what subject matter from the incorporated '698 patent is being referred to on page 5, lines 14-17. The sentence refers to the needles rotating "at 62 on the bearing surface 74 as an inner race in an manner similar to that described in the '698. This is confusing since the '698 patent does not have an inner race. Appropriate correction is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not include a means for angularly retaining the bearing on the trunnion.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 3, line 3, "the bearing" lacks proper antecedent basis since only a "bearing" assembly was set forth in claim 1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Van Dest.

Van Dest teaches a tripod joint with a spider 14 with three trunnions 16, a bearing assembly 34 is mounted on the trunnion and includes an inner race 18, an outer race 38 and a plurality of needles 32 between the inner and outer races 18,38. An elastic ring 28 axially retains the bearing assembly on the trunnion. The curved surface on the bottom of the trunnion 16 is a means for annularly retaining the bearing assembly on the trunnion since it would prevent the bearing assembly from pivoting on the trunnion. The inner race is in the form of a formed cup.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Dest as applied to claim 1 above.

Van Dest does not teach a non-machined outer surface on the trunnion. A non-machined surface would be rougher and therefore there would increased friction between the trunnion and the inner race which would prevent relative movement between the trunnion and the inner race. It would have been obvious for one of ordinary skill at the time the invention was made to not machine the outer surface of the trunnion so to increase the friction between trunnion and the inner race so to prevent relative movement between the trunnion and the inner race.

With respect to claim 5, this is a product by process claim. The patentability of a product-by process claim is predicated solely upon the patentability of the product structure and not how such was made. Therefore, the method steps will be given no patentable weight to in the consideration of this claim. If applicant wishes to submit separate method claims they will be subject to restriction.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kobayashi, Mizukoshi '653, Itoh et al, Hosdez et al, JA '721 to Uno and EP '665 to Van Dest all teach tripod joints.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Eileen D. Lillis whose telephone number is (703) 308-3248. The examiner can normally be reached on Monday through Thursday from 6:30 to 4:00 and every other Friday from 6:30 to 3:00.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168. The fax phone numbers for this Group are (703)305-3597; (703)305-7687 or (703) 306-4195.



Eileen D. Lillis
Primary Examiner
Group 3629

edl
24 May 1999